

REMARKS

Applicants initially wish to thank Examiner Kim for the interview with the undersigned (Applicants' representatives) on August 22, 2002. During that interview, the Office Action dated May 8, 2002 was discussed, and Applicants' representatives presented arguments regarding the distinguishing features of the present invention vis-à-vis U.S. Patent Nos. 5,208,762 to Charhut et al. in view of U.S. Patent No. 5,463,840 to Bailer. In the Interview Summary, Examiner Kim suggested condensing the claims, and agreed to give further consideration to the claims in view of the cited art upon receipt of our (this) response to the aforementioned Office Action.

In the Action dated August 28, 2002, the Examiner indicated that the claims do not comply with 37 C.F.R. 1.173, and that a supplemental paper correctly amending the reissue application is required. Applicants have reviewed the requirements of 37 C.F.R. §1.173, and have made appropriate changes to the amendment in order to comply with the requirements of 37 C.F.R. §1.173.

With regard to twice amended claim 6, only the correction of the typographical error (deleting "carries" and adding "carriers") was presented in the first amendment. With regard to the amendments to patent claims 1-6 and 8-14, support can be found in originally issued claims 1-3, and in the specification at least at column 8, line 15 – column 12, line 21. For example, with regard to deleting the term "automatic" in claims 1 and 3, independent claim 4 does not recite the term "automatic." With regard to the "the literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack" limitation added in claim 1 (and similarly added to claims 4, 8 and 10), support can be found at column 8, line 15 – column 12, line 21. With regard to the terms "bottle removing mechanism" (claim 5) and "assembly mechanism" (claim 5), support is found at least at column 8, line 15 – column 13, line 15. With regard to the amendment to claim 14 regarding applying an identifier prior to filling the prescription bottles with pills, support is found at least at column 4, lines 5-26.

Applicants have also made several amendments to the originally presented reissue claims. For example, limitations such as “automatic,” “separately from the at least one bottle inserted into the shipping container,” “corresponding to the prescription order,” and “star,” have been removed. In addition, the term “turntable” has generally been replaced with the phrase “assembly mechanism,” the phrase “mechanical arm” has generally been replaced with the phrase “bottle removing mechanism,” and the terms “prescription label,” “bar code,” and “tag” have generally been replaced by the term “identifier.” Support is found at least at claims 4-11, and column 8, line 15 – column 12, line 21.

In addition, in claim 30, for example, the phrase “said at least one OCP station determining which of the plurality of bottles goes into the at least one shipping container corresponding to the at least one of the prescription orders from the scheduled location of the plurality of bottles in said plurality of carriers,” has been replaced with the phrase “the literature pack and each of the bottles having at least one corresponding identifier identified by at least one identification system to ensure that each of one or more bottles associated with the corresponding prescription order are inserted into the shipping container with the corresponding literature pack.” Support is found at least at column 8, line 15 – column 12, line 21.

In claim 31, for example, the phrase “corresponding to the at least one of the prescription orders” has been replaced with the phrase “is inserted into the shipping container separately from the bottles.” Support is found at least in claim 1.

Claim 44, for example, has been amended to recite “each of the one or more bottles and the literature pack having at least one corresponding identifier identified by at least one identification system to ensure that the shipping container contains the one or more bottles corresponding to the prescription order and the corresponding literature pack.” Support is found at least at column 8, line 15 – column 12, line 21.

Claim 58, for example, has been amended to recite “the literature pack and each of the at least one bottle having at least one corresponding identifier identified by at least one identification system.” Support is found at least at column 8, line 15 – column 12, line 21.

Claim 75, for example, has been amended to recite “each of the one or more bottles and the literature pack having at least one corresponding identifier identified by at least one identification system to ensure that each of the at least one bottles associated with a prescription order is inserted into the shipping container with the corresponding literature pack. Support is found at least at column 8, line 15 – column 12, line 21.

Claim 91, for example, has been amended with regard to the term “identifier,” and with regard to adding the step “shipping the filled prescription order by sending the prescription order to a customer in a shipping container.” Support is found at least at column 8, line 15 – column 12, line 21.

Claim 96, for example, has been amended to recite the steps of “printing one or more literature packs customized to each of said at least one prescription order, the literature packs having a second identifier corresponding to a prescription order,” and “identifying, by an identification device, the first and second identifiers.” Support is found at least at claims 4-11, and column 8, line 15 – column 12.

Claim 104, for example, has been amended to recite the steps of “printing literature packs customized to a prescription order, the literature pack having a second identifier affixed thereto corresponding to the prescription order,” and “reading, by respective literature pack and prescription bottle readers, the literature pack and bottle identifiers.” Support is found at least at column 8, line 15 – column 12.

Claim 110, for example, has been amended to recite “printing a literature pack customized to a particular prescription order, the literature pack having a second identifier corresponding to the particular prescription order,” “identifying, by an identification device, the first and second identifiers,” and “using the read identifiers to pack at least one of the plurality of bottles and a corresponding literature pack in a shipping container.” Support is found at least at column 8, line 15 – column 12.

Claim 114, for example, has been amended to recite “each of the plurality of bottles having a first identifier affixed thereto corresponding to a prescription of a prescription order comprising one or more prescriptions,” “printing a literature pack customized to a particular prescription order, the

literature pack having a second identifier affixed thereto corresponding to the particular prescription order,” and “a packing station comprising at least one label reader that places a literature pack and one or more bottles corresponding to a prescription order into a shipping container.” Support is found at least at column 8, line 15 – column 12.

Claims 124 and 130, for example, has been amended with regard to the term “identifier.” Support is found at least at column 8, line 15 – column 12, line 21.

Claim 126, for example, has been amended to recite “printing a literature pack customized to a particular prescription order, the literature pack having a second identifier affixed thereto corresponding to the particular prescription order,” “reading electronically the literature pack and bottle identifiers,” and “using the read identifier information to pack at least one of the plurality of bottles and a corresponding literature pack in a shipping container corresponding to the prescription order.” Support is found at least at column 8, line 15 – column 12.

Claim 132, for example, has been amended to recite “printing a literature pack customized to each of a particular prescription order, the literature pack having second identifiers affixed thereto corresponding to the particular prescription order,” “reading electronically, by respective literature pack and prescription bottle readers, the literature pack and bottle identifiers,” and “packaging at least one of the plurality of bottles and a literature pack corresponding to prescription orders in containers, thereby providing individual prescription orders for shipping to customers.” Support is found at least at column 8, line 15 – column 12.

Applicants appreciate the Examiner’s indication of allowable subject matter. Applicants have amended allowable claims 5,17-29, 32, 34, 35, 45, 47, 48, 60, 61, 63, 64, 77, 79, 80, and 116-120, as discussed above. Applicants also note that the scope of these claims has also been changed by virtue of amending the respective independent claim from which they depend.

I. The Rejection Under 35 U.S.C. §103(a) is an Improper Omnibus Rejection

With regard to the rejection of claims 1-4, 6-16, 30-31, 36-44, 49-59, 65-76, 81-115 and 121-134, the Examiner states that Charhut teaches several elements, which presumably apply to the **claimed** invention, but in no way explains how several of the elements from Charhut relate to the **claimed** invention. That is, with regard to Charhut, there was absolutely no reference to several elements of the claims of the instant application, and absolutely no reasoning or explanation as to how the alleged teachings of Charhut teach these elements of the **claimed** invention. For example, the Examiner in no way discusses how Charhut teaches or suggests “a plurality of carriers,” “receptacles to receive a plurality of bottles, “ranks of carriers,” or that a “carrier has an identifier affixed thereto,” each of which are recited in various claims of the present invention. In addition, newly added claim 136 recites “a carrier with multiple bottles for dispensing pharmaceuticals,” which also is not taught or suggested by Charhut.

In the Office Action, the Examiner admits that Charhut “does not show a consolidation packaging station or literature insert packaging means as claimed,” and alleges, inter alia, that Bailer “teaches the concept of assembling orders wherein a literature insert is assembled for a particular order and placed into a carton.” The Examiner also alleges that “Charhut discloses printing particular labels for each corresponding vial” and “that radio tags are well known in the art,” and concludes from this that “it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Charhut with a shipping container with a corresponding literature package as taught by Bailer to provide for a shipping package with related literature, written information or instructions.”

On this basis, the Examiner rejected claims 1-4, 6-16, 30-31, 36-44, 49-59, 65-76, 81-115 and 121-134. Applicants respectfully submit that the form of the rejection was an omnibus rejection contrary to 37 CFR §1.104(c)(2) and MPEP 707.07(d). The Examiner is respectfully requested to clearly explain the pertinence of each reference as it relates to each element in each rejected claim as required by Rule 104 and to “fully and clearly” state the grounds for rejection as required by MPEP

Section 707.07(d). Nonetheless, Applicants have reviewed the references and traverse the rejections below with respect to various elements recited in the claims.

II. Charhut in View of Bailer Does Not Teach the Claimed Invention

A. Claims 1-3

Independent claim 1 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 1, the system comprises, inter alia, “one or more pill dispensing machines to automatically count out and simultaneously dispense pills into two or more prescription bottles in accordance with prescription orders.” The system also comprises “means to print literature packs customized to said prescription orders.” (emphasis added). In addition, the system comprises an “order consolidation means to present a shipping container for each prescription order, to insert the one or more prescription bottle for each prescription order into a shipping container and to insert, separately from any prescription bottle inserted into the shipping container, the literature pack for the prescription order into such shipping container.” Finally, claim 1 recites that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack.” This combination of features recited in claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited above. Without conceding that either reference discloses or suggests any of the elements recited in claim 1, both references absolutely fail to teach or suggest, in addition, at least the feature of printing a literature pack customized to a prescription order, or the feature of a literature pack being inserted separately from a bottle for a prescription order. In fact, neither reference discloses *anything* with regard to a literature pack being associated with a bottle of a prescription order. In this regard, Bailer discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23), and has nothing to do with printing literature packages, let alone printing “literature packs customized to said prescription orders,” as recited in the claimed invention. In this regard, Charhut

also does not teach or suggest that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 2-3 are not only allowable by virtue of their dependency from independent claim 1, but also because of additional features they recite. Claim 3, for example, recites that “the bottle identifiers are applied to said prescription bottles prior to dispensing pharmaceuticals into the bottles,” which is not taught or suggested by either Charhut or Bailer. In fact, Charhut teaches away from the claimed invention in this regard in Charhut teaches that vials are labeled “during or immediately following filling.” (col. 4, lines 1-4).

In view of the above, Applicants submit that the combination of features recited in each of claims 1-3 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 1-3 be passed to issue.

B. Claims 4, 6 and 7

Independent claim 4 recites a combination of features directed to a prescription dispensing and packing system. As recited by claim 4, the system comprises, inter alia, “a plurality of bottle carriers each having receptacles to receive a plurality of pill bottles.” The system also comprises “means to receive orders for prescriptions,” and “means to load prescription bottles corresponding to the prescriptions of said orders into scheduled locations in said carriers.” In addition, the system comprises “a prescription pill dispensing machine,” and “means to transport said carriers with said prescription bottles through said dispensing machine, said dispensing machine dispensing the pills of said orders into the bottles in said carriers in accordance with the scheduled locations of the pill bottles in said carriers.” The system further comprises “order consolidation means receiving carriers from said dispensing machine and presenting shipping containers to be filled, said order consolidation means unloading bottles from said carriers, printing a literature pack corresponding to prescription orders, and loading one or more bottles and a corresponding literature pack into a container for each order, said order consolidation means determining each bottle to go in each shipping container from the scheduled location of such bottle in a carrier.” Finally, claim 4 recites that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the shipping container contains the one or more bottles corresponding to the prescription order and the corresponding literature pack.”

This combination of features of independent claim 4, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Neither Charhut or Bailer teaches or suggests at least the combination of elements recited above. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 4, both references absolutely fail to teach or suggest at least the feature of an order consolidation means that unloads bottles from “carriers each having receptacles to receive a plurality of pill bottles.” (emphasis added). Both references also absolutely fail to teach or suggest at least the feature of loading prescription bottles corresponding to orders into scheduled locations in the carriers. In this regard, and contrary to the Examiner’s assertion, the carriers recited in the claimed invention cannot possibly correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut, as alleged by the Examiner. If the Examiner believes either Charhut or

Bailer teach or suggest, for example, “carriers each having receptacles to receive a plurality of pill bottles” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest a prescription dispensing and packaging system that “loads the bottles into shipping containers **corresponding** to the orders” (emphasis added) or a “prescription bottle having an identifier identified by at least one identification system to ensure that the shipping container contains the one or more bottles corresponding to the prescription order and the corresponding literature pack.”

Further, Bailer does not compensate for Charhut’s lack of disclosure of a consolidation packaging station. Instead, as noted above, Bailer discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23), and has nothing to do with an “order consolidation means” that unloads bottles from carriers and loads the bottles into “a shipping container for each order,” or loading prescription bottles corresponding to orders into scheduled locations in the carriers, each as recited in the claimed invention. Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 6-7 are not only allowable by virtue of their dependency from independent claim 4, but also because of additional features they recite. Claim 6, for example, recites, inter alia, “conveying means organizing said carriers into ranks of a plurality of carriers,” which is not taught or suggested by either Charhut or Bailer.

In view of the above, Applicants submit that the combination of features recited in each of claims 4, 6 and 7 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 4, 6 and 7 be passed to issue.

C. Claims 8 and 9

Independent claim 8 recites a combination of features directed to a system for assembling prescription orders. As recited by claim 8, the system comprises, inter alia, “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles in scheduled locations.” The system also comprises “means to assemble a plurality of carriers at said order and packing station, and packing means at said order and consolidation station to remove the prescription bottles of said order from the scheduled locations in the carriers of said plurality and pack the bottles of said order in a container with a corresponding literature pack, the literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the corresponding literature pack.”

This combination of features of independent claim 8, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Neither Charhut or Bailer teaches or suggests at least the combination of elements recited above. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 8, both references absolutely fail to teach or suggest, in addition, at least a prescription dispensing system having “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles in scheduled locations.” (emphasis added). In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles in scheduled locations” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the corresponding literature pack.” Other features are also clearly

absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 9 is not only allowable by virtue of its dependency from independent claim 8, but also because of additional features it recites. Claim 9 recites, inter alia, “means to print literature for said order.” Neither Charhut or Bailer disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 8 and 9 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 8 and 9 be passed to issue.

D. Claims 10 and 11

Independent claim 10 recites a combination of features directed to a system for sorting prescriptions by prescription order. As recited by claim 10, the system comprises, inter alia, “a carrier having the capability of receiving a multiplicity of prescription bottles in assigned locations.” The system also comprises “means responsive to a prescription of an order to provide one or more prescription bottles filled with pharmaceuticals in accordance with said prescription in an assigned location in said carrier.” The system comprises “an order consolidation and packing station comprising means to receive said carrier and remove said one or more prescription bottles from said assigned location in said carrier and pack said one or more prescription bottles and a corresponding literature pack in a container.” Finally, claim 10 recites that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding literature pack.”

This combination of features of independent claim 10, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Neither Charhut or Bailer teaches or suggests at least the combination of elements recited above. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 10, both references absolutely fail to teach or suggest at least the feature of “a carrier having the capability of receiving a multiplicity of prescription bottles”

in assigned locations.” (emphasis added). In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “a carrier having the capability of receiving a multiplicity of prescription bottle in assigned locations” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest that the literature pack and each prescription bottle have “an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding literature pack.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 11 is not only allowable by virtue of its dependency from independent claim 10, but also because of additional features it recites. Claim 11 recites, inter alia, “means to print literature corresponding to said order.” As noted above, neither Charhut or Bailer disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 10 and 11 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 10 and 11 be passed to issue.

E. Claims 12-15

Independent claim 12 recites a combination of features directed to method of sorting prescription bottles by prescription order. As recited in claim 12, the method comprises the step of, inter alia, “placing the one or more prescription bottles of each order in scheduled locations in carriers, each carrier having a multiplicity of locations to receive prescription bottles.” The method also comprises the step of “removing the one or more prescription bottles from the scheduled locations in said carriers in accordance with said record and placing the one or more prescription bottles and a corresponding literature pack of each order in a container.” In addition, the method comprises the steps of “identifying one or more prescription bottles corresponding to each order,” and “maintaining a record for each order of the identification of the carriers containing the one or more prescription bottles of each order and the scheduled location in said carriers of each of the one or more prescription bottles of each order.” This combination of features of independent claim 12, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Neither Charhut or Bailer teaches or suggests at least the combination of steps recited above. Without conceding that Charhut or Bailer discloses or suggests any of the steps recited in claim 12, both references absolutely fail to teach or suggest at least the step of “placing the one or more prescription bottles of each order in scheduled locations in carriers, each carrier having a multiplicity of locations to receive prescription bottles,” as recited in the claimed invention. (emphasis added). In fact, neither reference discloses *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest the step of “placing the prescription bottles of each order in scheduled locations in carriers, each carrier having a multiplicity of locations to receive prescription bottles” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and/or carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest “placing the one or more prescription bottles and a corresponding literature pack of each order in a container.” Other features are also

clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 13-15 are not only allowable by virtue of their dependency from independent claim 12, but also because of additional features they recite. Claims 14 recites that the “identifier is applied to each of the one or more bottles prior to filling said prescription bottles with pills,” which is not taught or suggested by either Charhut or Bailer.

In view of the above, Applicants submit that the combination of features recited in each of claims 12-15 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 12-15 be passed to issue.

F. Independent Claim 16

Independent claim 16 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 16, the system comprises, inter alia, “at least one order consolidation and packing (OCP) station.” The OCP station “presents a shipping container for each prescription order,” and “inserts at least one bottle for each prescription order into the shipping container and inserts a **corresponding** literature pack for each prescription order into the shipping container.” In addition, claim 16 recites that the literature pack and each of the at least one bottle have “at least one corresponding identifier identified by at least one identification system to ensure that the shipping container contains the at least one bottle associated with the prescription order and the corresponding literature pack.” This combination of features of independent claim 16, when interpreted as a whole and in combination with the other limitations recited in claim 16, is submitted to patentably distinguish over the prior art.

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited above. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 16, both references absolutely fail to teach or suggest, in addition, at least the feature of any form a printer for printing a customized literature pack. As noted above, both references absolutely fail to teach or suggest, in addition, at least the feature of printing a literature pack **corresponding** to a prescription order. In fact, neither reference discloses *anything* with regard to a literature pack being

associated with a prescription order. In this regard, Bailer discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23), and has nothing to do with printing literature packages, let alone printing literature packages corresponding to a prescription order, as recited in the claimed invention. In this regard, Charhut also does not teach or suggest that the literature pack and each bottle have “at least one corresponding identifier identified by at least one identification system to ensure that the shipping container contains the at least one bottle associated with the prescription order and the corresponding literature pack.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

In view of the above, Applicants submit that the combination of features recited in claim 16 is patentable over the prior art cited by the Examiner when claim 16 is interpreted as a whole. Accordingly, Applicants request that claim 16 be passed to issue.

G. Claims 30, 31 and 36-43

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 30. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 30, both references absolutely fail to teach or suggest, in addition, a prescription dispensing system having “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations,” as recited in the claimed invention. (emphasis added). In fact, neither reference discloses *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest, in addition, at least the feature of “loading at least one of the plurality of bottles and a corresponding customized literature pack

corresponding to a prescription order into a shipping container, the literature pack and each of the bottles having at least one corresponding identifier identified by at least one identification system to ensure that each of one or more bottles associated with the corresponding prescription order are inserted into the shipping container with the corresponding literature pack,” in combination with other claimed limitations. Charhut merely places a bin on a conveyor 24a, 24b, 24c. (col. 13:50-57). Charhut does not dispose of any items in a shipping container. Bailer, as noted above, places a generic literature package into a pocket or holder (see, e.g., col. 4, lines 21-23). The literature packages of Bailer do not have an “identifier identified by at least one identification system,” as recited in the claimed invention. Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

With regard to dependent claim 31, neither Charhut or Bailer teach or suggest that the “literature pack is inserted into the shipping container separately from the bottles,” particularly in combination with other claimed limitations as discussed with regard to claim 30. It is therefore respectfully submitted that dependent claim 31 is allowable over the art of record.

Applicants respectfully submit that dependent claims 36-43 are not only allowable by virtue of their dependency from independent claim 30, but also because of additional features they recite. Claim 38, for example, recites that “the shipping container has an identifier affixed thereto corresponding to each of the at least one prescription orders,” which is neither taught nor suggested by either Charhut or Bailer. Claim 40 recites that the transport devices organize the bottle carriers into “ranks of carriers.” Applicants find nothing in either reference with regard to a dispensing machine receiving “ranks of carriers,” particularly when taken in combination with the limitations recited in claim 30. Claim 41 recites additional details with regard to the shipping container. Applicants find nothing in either reference that teaches or suggests the features of the claimed invention recited in claims 41.

In view of the above, Applicants submit that the combination of features recited in each of claims 30, 31 and 36-43 is patentable over the prior art cited by the Examiner when each respective

claim is interpreted as a whole. Accordingly, Applicants request that claims 30, 31 and 36-43 be passed to issue.

H. Claims 44 and 49-57

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 44. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 44, both references absolutely fail to teach or suggest, in addition, a prescription dispensing system having “[a]t least one carrier, each having receptacles to receive at least one bottle in scheduled locations,” as recited in the claimed invention. (emphasis added). In fact, neither reference discloses *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “[a]t least one carrier, each having receptacles to receive at least one bottle in scheduled locations,” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and carriers are disclosed.

In addition, neither Charhut or Bailer teach or suggest, in addition, at least the feature of “at least one dispensing machine responsive to at least one prescription order comprising at least one prescription to fill one or more bottles in any of said at least one carrier with pharmaceuticals in accordance with the at least one prescription order,” or the feature of “at least one order consolidation and packing (OCP) station at which the one or more bottles corresponding to a prescription order are unloaded from said at least one carrier and placed in a shipping container with a literature pack corresponding to the prescription order,” each as recited in the claimed invention.

In addition, neither Charhut or Bailer teach or suggest that the one or more bottles and the literature pack have “at least one corresponding identifier identified by at least one identification system to ensure that the shipping container contains the one or more bottles corresponding to the prescription order and the corresponding literature pack.” Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims 49-57, Applicants respectfully submit that dependent claims 49-57 are not only allowable by virtue of their dependency from independent claim 44, but also because of additional features they recite. Claim 49 recites, for example, “printing a literature pack for the at least one prescription order,” which is not taught or suggested by either Charhut or Bailer.

Claim 45, for example, recites a “shipping container corresponding to the at least one prescription order,” which is not taught or suggested by either Charhut or Bailer. Claim 52 recites that “the shipping container has an identifier affixed thereto corresponding to each of the at least one prescription order.” Claim 55 also recites a “shipping container.”

Claim 54, for example, recites “ranks of carriers,” which is not taught or suggested by either Charhut or Bailer.

Further, with regard to claim 57, which recites “a radio frequency identifier,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc. and disclosed in applicant’s issued patents, such as pat no. 5660305.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the ‘305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request the Examiner to withdraw the rejection of claim 57.

In view of the above, Applicants submit that the combination of features recited in each of claims 44 and 49-57 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 44 and 49-57 be passed to issue.

I. Claims 58, 59 and 65-74

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 58. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 58, both references absolutely fail to teach or suggest, in addition, a prescription dispensing system having “[a] plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations,” as recited in the claimed invention. (emphasis added). In fact, neither reference discloses *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “[a] plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations,” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and carriers are disclosed.

In addition, and without conceding that Charhut or Bailer disclose or suggest any of the elements recited in claim 58, both references absolutely fail to teach or suggest, in addition, at least the feature of “at least one order consolidation and packing (OCP) station that receives said plurality of carriers from said at least one dispensing machine and presents shipping containers to be filled.” Also, neither reference teaches or suggested anything with regard to literature packs, which is also recited in claim 58.

In addition, neither Charhut or Bailer teach or suggest that the literature pack and each of the at least one bottle “have at least one corresponding identifier identified by at least one identification system so that the shipping container receives the at least one bottle and the literature pack corresponding to the prescription order.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 59 and 65-74 are not only allowable by virtue of their dependency from independent claim 58, but also because of additional features they recite. Claim 59 for example, recite that an order consolidation and packing station “determines

which of the at least one bottle is inserted in each respective shipping container from the respective literature pack identifier and respective prescription bottle identifier,” which is not taught or suggested by either Charhut or Bailer. Claims 65 recites “printing an identifier for each of the at least one of the plurality of bottles,” which is not taught or suggested by either Charhut or Bailer. Claim 71, for example, recites “ranks of carriers,” which is not taught or suggested by either Charhut or Bailer.

Further, with regard to claim 74, which recites “a radio frequency identifier,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio frequency identifiers are currently marketed is irrelevant. Further, even if radio frequency identifiers are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the ‘305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants request the Examiner to withdraw the rejection of claim 74.

In view of the above, Applicants submit that the combination of features recited in each of claims 58, 59 and 65-74 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 58, 59 and 65-74 be passed to issue.

J. Claims 75, 76 and 81-90

Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 75 both references absolutely fail to teach or suggest, in addition, at least the feature of “a plurality of carriers, each having receptacles to receive a plurality of bottles,” as recited in the claimed invention. (emphasis added). In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c

disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, both Charhut and Bailer absolutely fail to teach or suggest at least the feature of “at least one order consolidation and packing (OCP) station that receives said plurality of carriers from said at least one dispensing machine and presents shipping containers to be filled.” Finally, neither Charhut or Bailer teach or suggest that each of the one or more bottles and the literature pack have “at least one corresponding identifier identified by at least one identification system to ensure that each of the at least one bottles associated with a prescription order is inserted into the shipping container with the corresponding literature pack.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 76 and 81-90 are not only allowable by virtue of their dependency from independent claim 75, but also because of additional features they recite. Claim 76 recites that the “literature pack is inserted into the shipping container separately from the bottles.” Claims 81 and 82, for example, recite also recite a “literature pack” and details pertaining thereto, which are not taught or suggested by either Charhut or Bailer. Claim 87, for example, recites “ranks of carriers,” which is not taught or suggested by either Charhut or Bailer.

Further, with regard to claim 90, which recites “a radio frequency identifier,” the Examiner states that radio tags are well known in the art as they are marketed by Texas Instruments, Inc.” However, the mere fact that radio frequency identifiers are currently marketed is irrelevant. Further, even if radio frequency identifiers are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the ‘305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification

tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request the Examiner to withdraw the rejection of claim 90.

In view of the above, Applicants submit that the combination of features recited in each of claims 75, 76 and 81-90 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 75, 76 and 81-90 be passed to issue.

K. Claims 91-95

Independent claim 91 recites, inter alia, the step of “printing at least one literature pack **customized** to each of the at least one prescription order, the literature pack having a second **identifier** corresponding to the prescription order.” (emphasis added). As noted above, neither reference discloses *anything* with regard to a literature pack being associated with a prescription order. In particular, Bailer merely discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23), and has nothing to do with printing literature packages, let alone printing a customized literature package having an “identifier corresponding to the prescription order,” as recited in the claimed invention. Other features are also clearly absent from a cursory inspection of Charhut and Bailer.

Claim 91 also recites, inter alia, the step of “inserting the literature pack corresponding to each of the at least one prescription order into the shipping container.” Other features are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 92-95 are not only allowable by virtue of their dependency from independent claim 91, but also because of additional features they recite. Claim 93, for example, recites that “each first identifier is applied prior to dispensing.” As noted above, Charhut discloses labeling vials “during or immediately following filling.” (column 4, lines 1-4).

In view of the above, Applicants submit that the combination of features recited in each of claims 91-95 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 91-95 be passed to issue.

L. Claims 96-103

Independent claim 96 recites, inter alia, the step of “providing a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations.” (emphasis added). In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest the step of “providing a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations” and the step of “loading at least one of the plurality of bottles and a corresponding literature pack into a shipping container corresponding to each of the at least one prescription order as determined by the scheduled locations of the plurality of bottles,” each as recited in claim 96, he is requested to specify, by column and line number and/or Figure number, where such steps are disclosed.

Claim 96 also recites, inter alia, the step of “loading at least one of the plurality of bottles and a corresponding literature pack into a shipping container.” Other steps recited in claim 96 are also clearly absent from a cursory inspection of Charhut and Bailer. Finally, since several steps are missing, the combination of steps are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 97-103 are not only allowable by virtue of their dependency from independent claim 96, but also because of additional features they recite. Claim 99, for example, recites, inter alia, the step of “organizing the plurality of carriers into ranks of carriers.” Applicants find nothing in either reference with regard to organizing a plurality of carriers into ranks of carriers, particularly when taken in combination with the other limitations recited in the claim. Claim 100, for example, recites “providing a third identifier on the shipping container,” which is not taught or suggested by either Charhut or Bailer.

Further, claim 103 recites “a radio frequency identifier.” The Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc. and disclosed in

applicant's issued patents, such as Pat. No. 5,660,305." However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the '305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner's position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request the Examiner to withdraw the rejection of claim 103.

In view of the above, Applicants submit that the combination of features recited in each of claims 96-103 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 96-103 be passed to issue.

M. Claims 104-109

Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 104, both references absolutely fail to teach or suggest, in addition, at least the step of "providing a plurality of **carriers**, each having receptacles to receive a plurality of bottles in scheduled locations, each having a first **identifier affixed thereto** corresponding to a prescription order comprising at least one prescription." (emphasis added). In this regard, and as noted above, the Examiner's assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest the step of "providing a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations" as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

Claim 104 also recites, inter alia, the step of "packing the at least one of the plurality of bottles and a literature pack corresponding to the prescription order in a shipping container corresponding to

the prescription order.” Nothing in either Charhut or bailer teaches or suggests “shipping containers corresponding to shipping orders,” let alone one or more bottles and a literature pack corresponding to the prescription order, as recited in the claimed invention. Finally, since several elements are missing, the combination of elements are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 105-109 are not only allowable by virtue of their dependency from independent claim 104, but also because of additional features they recite. For example, with regard to claim 109, which recites “a radio frequency identifier,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc. and disclosed in Applicants’ issued patents, such as, Pat. No. 5,660,305.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the ‘305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request the Examiner to withdraw the rejection of claim 109.

In view of the above, Applicants submit that the combination of features recited in each of claims 104-109 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 104-109 be passed to issue.

N. Claims 110-113

Neither Charhut or Bailer teaches or suggests at least the combination of steps recited in claim 110. Without conceding that Charhut or Bailer discloses or suggests any of the steps recited in claim 110, both references absolutely fail to teach or suggest at least the step of “receiving a plurality of bottles, each having a first identifier affixed thereto corresponding to a prescription of a prescription order comprising at least one prescription and an assigned location in a bottle **carrier** corresponding

to a prescription order.” (emphasis added). In this regard, and as noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest the step of “the step of “receiving a plurality of bottles, each having an assigned location in a bottle carrier corresponding to a prescription order comprising at least one prescription,” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, neither reference teaches or suggests “using the read identifiers to pack at least one of the plurality of bottles and a corresponding literature pack in a shipping container,” or “printing a literature pack customized to a particular prescription order, the literature pack having a second identifier corresponding to the particular prescription order.” Finally, since several steps are missing, the combination of steps are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 111-113 are not only allowable by virtue of their dependency from independent claim 110, but also because of additional features they recite. For example, claim 112 recites the step “providing a third identifier on the shipping container.” As previously noted, Applicants find nothing in either reference with regard to providing an identifier on a shipping container.

In view of the above, Applicants submit that the combination of features recited in each of claims 110-113 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 110-113 be passed to issue.

O. Claims 114-115 and 121-123

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 114. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 114, both references absolutely fail to teach or suggest at least “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations.” (emphasis added). As noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be

correct. If the Examiner believes either Charhut or Bailer teach or suggest, for example, “a plurality of carriers, each having receptacles to receive a plurality of bottles in scheduled locations,” as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, neither reference teaches or suggests “at least one dispensing machine responsive to said computer that automatically counts and dispenses the type and quantity of pharmaceuticals into the plurality of bottles in accordance with the prescription orders in the scheduled locations of the corresponding plurality of carriers.” Finally, since several elements are missing, the combination of elements are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 115 and 121-123 are not only allowable by virtue of their dependency from independent claim 114, but also because of additional features they recite. Claim 115, for example, recites that “the shipping container has a third identifier affixed thereto.” Applicants find nothing in either reference with regard to a shipping container, let alone a shipping container with an identifier affixed thereto.

Further, with regard to claim 123, which recites “a radio frequency identifier,” the Examiner states that “radio tags are well known in the art as they are marketed by Texas Instruments, Inc. and disclosed in Applicant’s issued patents, such as Patent No. 5,660,305.” However, the mere fact that radio tags are currently marketed is irrelevant. Further, even if radio tags are well known, that fact alone is irrelevant to the claimed invention of an automatic prescription filling system. Finally, in their response to the Office Action dated November 5, 2001, Applicants have indicated that U.S. 5,660,305 is not prior art with respect to the present application since the ‘305 patent and the present application were commonly owned at the time of the present invention. Accordingly, the Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to radio frequency identification tags pursuant to MPEP §2144.03, or an affidavit under 37 C.F.R. §1.104 (d)(2). In the absence of either, Applicants respectfully request the Examiner to withdraw the rejection of claim 123.

In view of the above, Applicants submit that the combination of features recited in each of claims 114, 115 and 121-123 is patentable over the prior art cited by the Examiner when these

claims are interpreted as a whole. Accordingly, Applicants request that claims 114, 115 and 121-123 be passed to issue.

P. Claims 124-129

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 124. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 124, both references absolutely fail to teach or suggest dispensing “at least one prescription into one or more bottles positioned in one or more carriers, each carrier having receptacles to receive a plurality of bottles,” as recited in the claimed invention. (emphasis added). As noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest, for example, dispensing “at least one prescription into one or more bottles positioned in one or more carriers, each carrier having receptacles to receive a plurality of bottles,” he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, claim 124 has been amended to recite “reading electronically the literature pack and bottle identifiers,” and “using the read identifier information to pack at least one of the plurality of bottles and a corresponding literature pack in a shipping container corresponding to the prescription order.” Applicants do not find any teaching in either Charhut or Bailer regarding these features. Since several elements are missing, the combination of elements are also submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims 125-129, Applicants respectfully submit that these claims are not only allowable by virtue of their dependency from independent claim 124, but also because of additional features they recite. Claim 128, for example, recites the step of “providing a third identifier on the shipping container.” Applicants find nothing in either reference with regard to printing literature packs corresponding to the prescription order.

In view of the above, Applicants submit that the combination of features recited in each of claims 124-129 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicants request that claims 124-129 be passed to issue.

Q. Claims 130-134

Neither Charhut or Bailer teaches or suggests at least the combination of elements recited in claim 130. Without conceding that Charhut or Bailer discloses or suggests any of the elements recited in claim 130, both references absolutely fail to teach or suggest dispensing “at least one prescription into one or more bottles positioned in one or more carriers, each carrier having receptacles to receive a plurality of bottles,” as recited in the claimed invention. (emphasis added). As noted above, the Examiner’s assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes either Charhut or Bailer teach or suggest, for example, dispensing “at least one prescription into one or more bottles positioned in one or more carriers, each carrier having receptacles to receive a plurality of bottles,” he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed. Since several elements are missing, the combination of elements are also submitted to patentably distinguish over the prior art.

In addition, claims 130 has been amended to recite “reading electronically, by respective literature pack and prescription bottle readers, the literature pack and bottle identifiers,” and “packaging at least one of the plurality of bottles and a literature pack corresponding to prescription orders in containers.” Applicants do not find any teaching or suggestion in either Charhut or Bailer regarding these limitations.

Accordingly, and for at least this reason, Applicants submit that the combination of features recited in each of claims 130-134 is patentable over the prior art cited by the Examiner when these claims are interpreted as a whole. Accordingly, Applicant requests that claims 130-134 be passed to issue.

III. Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, that is patentable. Applicants have emphasized certain features in the claims as clearly not present in the claims, as discussed above. However, Applicants do not concede that other features in the claims are also not missing in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why each of the claims described above are distinguishable over the cited prior art.

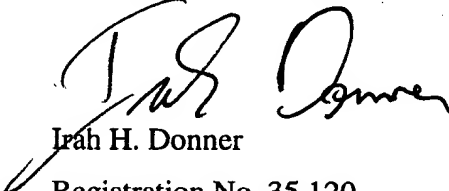
For all the reasons advanced above, Applicants respectfully submit that the rejections must be withdrawn. Consequently, issuance of a Notice of Allowance is respectfully requested.


Authorization

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,


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